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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,897	02/02/2004	David J. Danitz	PAT-1337-CIP3CON	1109

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EXAMINER	
NGUYEN, TUAN VAN	
ART UNIT	**PAPER NUMBER**
3731	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/770,897	DANITZ ET AL.	
	Examiner	Art Unit	
	Tuan V. Nguyen	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-8 and 13 is/are rejected.

7)☒ Claim(s) 14-24 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 02 February 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 02/02/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 19 is objected to because of the following informalities: Here it is noted that applicant intended to recite "The clamp of claim 18, wherein the plurality of telescoping tubes has a distal telescoping tube that is removably coupled to the gripping assembly when the telescoping tubes **are fully deployed to completely cover the flexible shaft**". Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. Claim 13 recites the limitation "a rigid element having a proximal end that is **removably** coupled to the handle assembly... and wherein the shaft can be bent when either the proximal end or the distal end of the rigid element is removed from either the handle assembly or the gripping assembly, respectively" is unclear to when is the proximal end of rigid element is being removed from the handle assembly. Turning to specification and drawings for guidance, one finds (see Figs. 2, 6A, 6B, 27, 33A, and 33B), here it is understood that the design intend of the rigid element is to allow the surgeons to **slidably** couple the rigid element with respect to the handle assembly during a surgical procedure. The design intends is not allow the surgeons to remove component 114 (see Fig 6A) or 502 (see Figs 33A) during a surgical procedure to removably couple the rigid element to the handle assembly. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Morejohn et al (U.S. 6,146,394).**

5. Referring to claims 1-3, Morejohn et al disclose a surgical clamping device having a handle assembly, a gripping assembly 410 having a pair of jaws 432 being parallel to each other when they are opened and when they are closed (see Figs. 15 and 16), a flexible shaft 392 having a proximal end 394 operatively coupled to the handle assembly and a distal end 396 that is operatively coupled to the gripping assembly (see col. 9, lines 36-47).

6. Referring to claims 5 and 6, Morejohn et al disclose a surgical clamping device having a cable 400 carried within the shaft with a proximal end coupled to the handle assembly (see col. 9, lines 46-47); a distal end 392 of the shaft coupled to the gripping assembly (see Fig. 17); and wherein the gripping assembly includes: a jaw housing 408, a cable terminator 404 movably retained inside the jaw housing and secured to the distal end of the cable, and a link 434 that pivotally coupled to the cable terminator at 444.

7. Referring to claim 7, Morejohn et al disclose each link includes a first link 436 and second link 438 (see Figs 16 and 17).

8. **Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Malecki et al (U.S. 5,626,607).**

9. Referring to claims 1-3, Malecki et al disclose a clamp 170 comprising a handle assembly 90, a gripping assembly having a pair of jaws 82, 84 being parallel to each other when they are opened and when they are closed (see Figs. 7 and 8), and a flexible shaft 72 having a proximal end operatively coupled to the handle assembly and a distal end operatively coupled to the gripping assembly.

10. Referring to claim 8, Malecki et al disclose (see Figs. 7 and 8) each jaw receives an insert 83 or 85 on the jaws.

11. **Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Maslanka (U.S. 4,467,802).**

12. Referring to claim 13, Maslanka disclose (see Fig.) a surgical gripping instrument comprising: a gripping assembly having a pair of jaws 10a, 10b; a handle assembly 26, 22; and a core 12 or shaft, wherein the shaft is flexible shaft having a proximal end that is removable coupled to the handle assembly at 24, and a distal end that is removable coupled to the gripping assembly; and a rigid element 44. The rigid element has a proximal end that is slidably coupled to the handle assembly, and a distal end, which includes mounting 46, cable 14, and sleeve 18, that is removably coupled to the gripping elements 10a, 10b, and 10c. Here it is noted that when the distal end of rigid element is moved to the left in the Figure

then it is removably coupled to the gripping assembly by friction between the sleeve 18 and the gripping elements (see col. 3, lines 30-52).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claim 4 is ejected under 35 U.S.C. 103(a) as being unpatentable over Morejohn et al (U.S. 6,146,394) further in view of Maslanka (U.S. 4,467,802)

15. Referring to claim 4, Morejohn et al disclose the invention substantially as claimed except for a rigid element that can be placed in a first position where the rigid element supports the shaft in a manner where the shaft cannot be bent, and in a second position where a portion of the shaft can be bent. Maslanka disclose a

surgical gripping instrument having a second rack 44 or rigid element wherein rigid element supports the shaft in a manner where the shaft cannot be bent, and in a second position where a portion of the shaft can be bent (see col. 3, lines 30-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to include the rigid element, as disclosed by Maslanka, in the device, as disclosed by Morejohn et al, because this will provide the surgeon the ability to turn the shaft into a rigid and straight shaft.

Allowable Subject Matter

16. Claims 14-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8, and 39 of U.S. Patent No. 6,638,287 to Danitz et al. Claims 13-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8, 9, and 39 of U.S. Patent No. 6,638,287 to Danitz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other.

19. Claims 1 and 4 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 18 of U.S. Patent No. 6,676,676 to Danitz et al. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 18, 23, and 28 of U.S. Patent No. 6,676,676 to Danitz et al. Claims 14-16 are rejected on

the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 6, and 12 of U.S. Patent No. 6,676,676 to Danitz et al. Claims 18-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-36 of U.S. Patent No. 6,676,676 to Danitz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other.

20. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 16 of U.S. Patent No. 6,544,274 to Danitz et al. Claims 17-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 14 and 15 of U.S. Patent No. 6,544,274 to Danitz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other.

21. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 4, 5 and 8 of U.S. Patent No. 6,685,715 to Danitz et al. Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1,of U.S. Patent No. 6,685,715 to Danitz et al. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,238,414 to Griffiths.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
November 20, 2005

ANHTUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER
11/28/05